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OFFICE OF PETITIONS

In re Application
Kawakami et al.
Application No. 09/676,090
Filed: October 2, 2000
Atty Docket No. 839.438

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: DECISION ON APPLICATION
: FOR PATENT TERM ADJUSTMENT
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This is a decision on the "REQUEST FOR CORRECTED NOTICE OF ALLOWANCE AND APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(b)," filed December 3, 2003. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to sixty-seven (67) days.

The application for patent term adjustment is GRANTED to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **sixty (60) days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On October 21, 2003, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above identified application. The Notice stated that the patent term adjustment (PTA) to date is zero (0) days. On December 3, 2003, applicants timely¹ submitted an application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is sixty-seven (67) days.

Applicants assert entitlement to a patent term adjustment of 67 days on the basis that the USPTO improperly assessed applicant delay of one hundred and twenty (120) days for an Information Disclosure Statement (IDS) filed on January 28, 2003. Applicants point out that the IDS was filed as the submission accompanying a Request for Continued Examination (RCE).

¹ PALM records indicate that the issue fee was not paid prior to the filing of this petition.

Applicants specifically state that the patent issuing from the application is not subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of zero (0) days based on an adjustment for PTO delay of one hundred seventy-one (171) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1), reduced by applicants' delays of thirty-nine (39) days and sixty-five (65) days, both pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b), as well as applicants' delay of one hundred twenty (120) days due to the filing of the IDS. The PTO delay of 171 days and applicants' delays of 65 and 39 days have been reviewed and found to be correct. The reduction of 120 days is at issue.

The reduction of 120 days has been found to be incorrect. A review of the application file reveals that the IDS filed on January 28, 2003 was filed as the submission required by an RCE, and was not a supplemental reply or other paper pursuant to 37 C.F.R. § 1.704(c)(8). Accordingly, applicants should not have been assessed a delay of 120 days for filing the IDS.

However, the RCE filed on January 28, 2003, was filed in response to a Notice of Allowance mailed October 21, 2002. As such, the RCE was not timely filed within the three month time period set by 37 C.F.R. § 1.704(b).² Accordingly, applicants should have been assessed a delay of seven (7) days.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **sixty (60) days** (171 days of PTO delay, reduced by 111 days of applicants' delay (39 days + 65 days + 7 days)).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e).

The application file is being forwarded to Group Art Unit 1723 for the examiner to consider applicants' request to correct the title of the invention.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (703) 305-0272.

Karin Ferriter

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of Revised PAIR Screen

² The RCE included a Certificate of Mailing under 37 C.F.R. § 1.8 dated January 21, 2003, making it timely in response to the Notice of Allowance. However, Certificates of Mailings are not taken into account in the PTA calculation. See 37 C.F.R. § 1.703(f).